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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,202	06/28/2000	Frank J. Jakubaitis	61466-250470	7617

8791 7590 01/24/2005

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,202

Applicant(s)

JAKUBAITIS, FRANK J.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-9 and 12-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,4-9 and 12-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant amended Claims 1, 7, 8, and 9, canceled Claims 2, 3, 10, and 11, and newly added Claims 15-19. All pending claims (1, 4-9, and 12-19) were examined in this final Office Action necessitated by amendment.

Response to Arguments

Rejection under 35 USC 103

Applicant's arguments, see Remarks, filed 22 October 2004, with respect to the rejection(s) of claim(s) 1, 4-9, and 12-15 and newly added Claims 16-19 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Fiala and Liu as necessitated by amendment. Fiala teaches a system and method of activating a metered account managed by a remote computer from retail point-of-sale systems using a prepaid card purchased by a customer at a merchant location. The prepaid purchase is for goods or services to be accessed via the remote computer from a customer's computer. Liu teaches distributing digital content as a service (e.g. music or other multimedia content), payment using a prepaid card or other forms of payment, the customer accessing the stored digital content at the remote server, and downloading the content to the customer using authentication information.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 6-9, and 13-19 are rejected under 35 USC 103(a) as being unpatentable over Fiala et al. (Paper #4, patent number 5,918,909 hereinafter referred to as "Fiala"), in view of Liu (patent number 5,953,005).**

Fiala teaches a system and method of activating a metered account from retail point-of-sale systems remotely connected to a computer over a communications network. Fiala further teaches:

- Purchasing from the retail merchant a package associated with desired goods or services: a package for holding a data-encoded card associated with a metered account; displayed on merchant's display rack; activated at time of purchase from a retail merchant (see at least col. 2, lines 2-26; col. 4, lines 58-62; col. 5, lines 8-10).
 - package identifier, identifier displayed on outer surface; identifier being a code; uniquely identifies goods or services being purchased: a unique first identification number comprising a control number (see at least col. 18, lines 54-58); observing the exposed

Art Unit: 3625

control number on the card (see at least col. 19, lines 7-8); provider of goods or services uniquely associates the control number and PIN with the metered account (see at least col. 19, lines 19-22).

- the outer surface of the package displaying a description of the content of the goods or services: printed advertisements, coupons, instructions or other information printed on the front and/or back of package (see at least col. 13, lines 35-40).
- Sending a request from a merchant node associated with the retail merchant to the remote server to set a status of the desired goods or services as available for access based on the package identifier:
remote computer is electronically linked to merchant locations;
characterization information read at merchant location and transmitted to the remote computer to activate the metered account (please note examiner's interpretation: activating the account provides an indication of availability) (see at least col. 19, lines 29-44; col. 19, line 64 through col. 20, line 5).
- Remote server receiving the request; searching good or services stored on the remote server for the desired goods or services specified by the package identifier; setting the status of the desired goods or services as available for access: please note examiner's interpretation: as noted by the above teachings, the action of activating the account provides an indication of availability).

- *Sending a request to access the desired goods or services from the customer node through the communications network; specifying the desired goods or services identification data; receiving at the remote server the request:* customer enters a password via a customer computer connected to the remote computer to gain access to goods or services (see at least col. 20, lines 6-27).
- *Identifying the goods or services based upon the received identification data:* Fiala inherently discloses a method that permits the functioned to be performed- the remote computer provides access to goods or services associated with unique identification information.
- *Packaging options:* metered account being exposed on the outer surface; magnetic stripe with encoded identification information (see at least abstract; Fig. 1 (C, S); col. 2, lines 30-36; col. 5, lines 15-20); package includes a card (please note: package-card arrangement depicts card as integral part of the package (i.e. card is the package) (see at least Fig. 1 (30, c)).

Fiala teaches all the above as noted under the 103(a) rejection and teaches a) metered accounts for goods or services, b) purchasing a prepaid card at a merchant location to acquire goods or services via a remote computer from a customer computer, and c) the remote computer providing the online customer with access to goods or services after

providing identification information stored in the remote computer (see at least col. 20, lines 20-21), but does not teach storing digital works. Liu teaches it would be beneficial to both commercial and home users for the distribution of Karaoke and other multimedia content to be provided online by an Internet distribution system (see at least col. 2, lines 11-14). Liu teaches a system and method of downloading digital content (e.g. songs) (hereinafter referred to as "digital works") into a customer computer over the Internet and providing other goods or services. Liu teaches the customer prepaying for the digital works with a prepaid card to gain access to the controlled content, using a password or a handshake with a form of personal identification (e.g. prepaid card) for download authentication, and subsequent downloading of digital works stored on a remote server to the customer computer (see at least abstract; Fig. 4 (104, 106); Fig. 7; col. 2, lines 15-60; col. 3, lines 20-33; col. 5, lines 9-17; col. 6, lines 21, 28-33). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Fiala to disclose digital works stored on the remote server as taught by Liu, in order to capture customers desiring to prepay for online music or other online content, and thereby increase sales for retail merchants selling prepaid access services.

Fiala teaches all the above as noted under the 103(a) rejection but does not teach logic and control. Liu teaches all the above as noted under

the 103(a) rejection and teaches control threads (see at least col. 5, lines 5, 20-21; col. 6, lines 51-55). Liu further teaches system logic (see at least Fig. 5 (124); Fig. 7; Fig. 8; Fig. 9; Fig. 10). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Fiala to disclose logic and control as taught by Liu, in order in order to capture customers desiring to prepay for online music or other online content, and thereby increase sales for retail merchants selling prepaid access services.

Pertaining to system Claims 9, 13-15, 18 and 19

Rejection of Claims 9, 13-15, 18 and 19 is based upon the same rationale as noted above.

2. **Claims 4 and 12 are rejected under 35 USC 103(a) as being unpatentable over Fiala (Paper #4, patent number 5,918,909) and Liu (patent number 5,953,005), as applied to Claims 1 and 9, further in view of Official Notice (Paper #16, regarding ordinary skill in the art).**

Fiala and Liu teach all the above as noted under the 103(a) rejection and teach a) PIN numbers packaged as being obscured and exposed with unique identifiers packaged as fully exposed or partially exposed, and b) applying a sticker to obscure the PIN, but do not disclose the unique identifier packaged as being obscured. It would have been obvious to one of ordinary skill in the art at time of the invention to modify the system of Fiala and Liu to disclose fully

obscuring the unique identifier with an obscured PIN, since one of ordinary skill in the art would ascertain the identifier could be fully obscured with the techniques disclosed, and thereby provide additional account protection.

Pertaining to system Claim 12

Rejection of Claim 12 is based upon the same rationale as noted above.

3. **Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Fiala (Paper #4, patent number 5,918,909) and Liu (patent number 5,953,005), as applied to Claim 1, further in view of White et al. (Paper #16, patent number 6,169,975 hereinafter referred to as "White").**

Fiala and Liu teach all the above as noted under the 103(a) rejection and teach a) consumers purchasing a package containing a prepaid card with a personal access code used to gain access to services and digital information, but do not disclose printing a PIN number for the consumer. White teaches consumers purchasing a prepaid card for services at a point-of-distribution, a prepaid card containing a magnetic strip for reading, and further teaches printing the PIN for the consumer on a paper receipt (see at least abstract; col. 2, lines 23-40). Therefore it would have been obvious to one of ordinary skill in the art to modify the method of Fiala and Liu to disclose printing a receipt containing the PIN as taught by White, in order for the consumer to know what number is valid for the prepaid card.

Application/Control Number: 09/607,202
Art Unit: 3625

Page 9

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', with a stylized flourish at the end.

Robert M. Pond
Primary Patent Examiner
January 21, 2005